

Remarks/Arguments

This Amendment is intended to be a complete response to the Office Action dated March 2, 2006, and the case is believed to be in better condition for allowance. Accordingly, reconsideration is respectfully requested. Claims 1-3, 5-14, and 16-25 are pending in the application, and stand rejected at present. Claim 2 is canceled herein.

Claims 1-3, 5-14, and 16-25 were rejected under 35 U. S. C. 112, first paragraph, as failing to comply with the written description requirement, on the basis that there was no support in specification for the “proviso that the colloidal particles are not mica particulates” inserted into independent claims 1 and 12. MPEP §2173.05(i) reads, in pertinent part, as follows:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed.Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter.1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Under MPEP §2173.05(i), elements positively recited in the specification, may be explicitly excluded in the claims. Also, Applicants note that the content of the specification includes the background of the invention (see MPEP §608.01(a) under the heading "Content of Specification").

In the specification as originally filed, on page 2, at paragraph 6, the use of mica in polymeric and VES-based fluids is disclosed. Therefore, since the use of mica is positively recited in the original specification, mica may be explicitly excluded in the claims by proviso. Thus, Applicants believe claims 1-3, 5-14, and 16-25 comply with the written description requirement, that no new matter is added by adding the proviso, and respectfully request withdrawal of the rejection.

Claims 1 and 11 are rejected under 35 U. S. C. 102(a) and (e) as being anticipated by Samuel et al. in U.S. Patent Application Publication 2003/0166471. Claim 1 has been amended herein to incorporate the limitation of claim 2, and claim 11 depends upon amended claim 1. Applicants do not believe Samuel anticipates Applicants' invention as claimed.

Amendments to the independent claims have been made to place the application in better condition for allowance. Amendments made to the independent claims are applicable to the claims dependent thereon. Applicants submit that this paper is fully responsive to the comments in the Office Action and respectfully solicit for this application to be granted in light of these amendments and remarks. If the Examiner believes that the prosecution of the application would be facilitated by a telephone interview, Applicants invite the Examiner to contact the undersigned at 281-285-8606. The Commissioner is authorized to charge any additional required fee, or credit any excess fee paid, to Deposit Account 04-1579 (56.0726).

Appl. No. 10/707,011
Amdt. Dated: Apr. 25, 2006
Response to Office Action Dated Mar. 2, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D L Cate', written in a cursive style.

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